UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,360	03/18/2004	James Kevin Gillie	A1019-20354	5836

3000 7590 06/21/2005

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.
11TH FLOOR, SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA, PA 19103-2212

EXAMINER	
TRAN, THAO T	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/803,360	GILLIE, JAMES KEVIN	
	Examiner	Art Unit	
	Thao T. Tran	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-48 is/are pending in the application.

4a) Of the above claim(s) 25-48 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/28/04;6/16/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-24, drawn to a film, classified in class 428, subclass 411.1.

II. Claims 25-48, drawn to a method of making a film, classified in class 427, subclass 331.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by a materially different process that would require different step(s), such as a biaxially orientation of the base film before applying the urethane coating.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Gary Greene on April 20, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-48 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 8, 11-17, 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita et al. (US Pat. 5,824,394).

Kinoshita teaches a laminate, comprising a polyester film comprising polypropylene (in layer B) and a coating comprising urethane-based resin (see abstract; col. 2, ln. 33-43; col. 9, ln. 28-35; Example 6). The urethane-based resin is water soluble, containing an acrylic-based polyol and a crosslinking agent, such as aziridine, and an antiblock agent (see col. 7, ln. 7-17, 33; col. 8, ln. 24-35). The polyester film may be surface treated with chemical or discharge (oxidative)

treatment before coating (see col. 9, ln. 62-67). The polyester film further comprises an antiblock agent (slip agent) such as silica in an amount of 0.1% (see col. 15, ln. 34-37).

Moreover, it is hereby noted that although Kinoshita teaches the same steps of stretching of the film as presently claimed, it is the structural elements that impart patentability to an article claim, and not how the layers are made.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 7, 9-10, 12, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita as applied to claims 1, 8, 11.

Kinoshita is as set forth in claims 1, 8, and 11 and incorporated herein.

In regards to claim 7, Kinoshita teaches that the coating layer contains acrylic-based resin or urethane-based resin (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine these two resins because it has been held obvious that combining two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See MPEP 2144.06.

In regards to claims 9-10, 12, although Kinoshita does not specify the amount of the antiblock agent or the crosslinking agent in the coating layer, since Kinoshita teaches that the

amount of the antiblock agent or the crosslinking agent in the polyester film is 0.1%, it would have been obvious that the amounts of these agent in the coating layer would be the same as that in the polyester film, in order to have the layers more compatible with each other in terms of crosslinking and/or antiblocking. Moreover, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the concentration of a compound would have been determined by routine experimentation in order to achieve the desired results, such as crosslinking and/or antiblocking.

In regards to claims 18-20, although Kinoshita does not specifically teach the polypropylene to be a homopolymer, copolymer, or a combination thereof, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the polypropylene would have been one of these three possibilities, and the use of them would have given the same results since they are alternative of each other as disclosed in the present specification. Moreover, it has been within the skill in the art that the selection of a known material based on its suitability for its intended use would have been obviousness determination. See MPEP 2144.06, 2144.07.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
June 14, 2005

Thao Tran

THAO T. TRAN
PATENT EXAMINER